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DEC 30 2005

TECHNOLOGY CENTER 2100

In re Application of: Watanabe
Application No. 10/669,325
Filed: September 25, 2003
For: REMOTE COPY SYSTEM

DECISION ON PETITION
UNDER 37 CFR §1.181 FOR
SUPERVISORY REVIEW

This is a response to the "PETITION TO DIRECTOR UNDER 37 CFR §1.181 OF DENIAL OF PETITION TO MAKE SPECIAL" filed 24 October 2005, under 37 C.F.R. §1.102(d) and M.P.E.P. §708.02 (VIII): Accelerated Examination, to make the above-identified application special.

On 16 May 2005, a decision was mailed dismissing the original petition filed 07 March 2005.

On 23 August 2005, a decision was mailed denying the renewed petition filed 12 July 2005.

The Petition is **DENIED**.

M.P.E.P. §708.02, Section VIII which sets out the prerequisites for a grantable petition for Accelerated Examination under 37 C.F.R. §1.102(d) states in relevant part:

A new application (one which has not received any examination by the examiner) may be granted special status provided that applicant (and this term includes applicant's attorney or agent) complies with each of the following items:

...

(d) Submits one copy each of the references deemed most closely related to the subject matter encompassed by the claims if said references are not already of record; and

(e) Submits a detailed discussion of the references, which discussion points out, with the particularity required by 37 CFR 1.111 (b) and (c), how the claimed subject matter is patentable over the references.

The petition filed 07 March 2005 was dismissed in a decision mailed 16 May 2005 for failing to adequately meet requirement (e) of the criteria set forth above. It was noted that the discussion of the references failed to point out with the particularity required by 37 CFR 1.111(b) and (c) how the claimed subject matter is patentable over the references. Specifically, it was noted that

[t]he discussion fails to specifically point out how the language of claim 11 patentably distinguishes it from the references. At least some of the features purported to be in claim 11 do not appear in that claim. For example, claim 11 does not specify "transmit[ting] to the *third storage unit system* a journal including write data and an address of the write data" (emphasis added) or "a function of the *second controller . . .*" (emphasis added). Also, regarding the discussion of the Nakano reference, claim 11 does not specify sending the journal "to the *third storage unit* from the first storage unit" (emphasis added) or acquiring "the journal from the *third storage unit*" (emphasis added).

The petition filed 12 July 2005 was denied in a decision mailed 23 August 2005 for failing to adequately meet requirement (e) of the criteria set forth above. It was noted that the discussion of the references failed to point out with the particularity required by 37 CFR 1.111(b) and (c) how the claimed subject matter is patentable over the references. Specifically, it was noted that

[t]he renewed petition identifies a first and second feature of independent claim 1 and a third and fourth feature of independent claim 11. However, in identifying these features, the discussion states that the references "fail to disclose or suggest [the identified features] *in combination* with the other limitations recited in the claims" (emphasis added). It is also stated in the discussion of each reference that the reference "does not disclose or suggest" the identified features for each independent claim "*in combination* with the other limitations recited in each of the independent claims" (emphasis added). In effect, this statement indicates that the *entirety* of the two independent claims is not disclosed by the references purported to be most closely related. Such a statement is not a sufficient detailed description.

The discussion regarding claim 11 in the decision mailed 16 May 2005 is not disputed.

Regarding the decision mailed 23 August 2005, it is urged that "arguing that specific features in combination with other limitations of the claims renders the claims patentable over the references is highly appropriate and satisfies the requirements of 37 CFR §1.102(b)." While such an argument may be appropriate to distinguish the claims from the references in regard to obviousness, it is not appropriate to distinguish the claims from the references in regard to anticipation. As noted in the decision mailed 23 August 2005, the statement attempting to distinguish the claims from the references in effect states that the entirety of the independent claim is not disclosed by the reference. A statement that the entirety of each independent claim is not disclosed by the references purported to be "most closely related" is not a sufficient detailed description as to anticipation. The petitions fail to point out which particular feature or features are not shown by the references such that the claims are not anticipated. I.e., regarding anticipation, stating that the references fail to show the claim in its entirety is simply a general allegation that does not comply with the requirements of 37 CFR 1.111(b) and (c).

Accordingly, Applicant has not met the criteria for the granting of a Petition for accelerated examination. The petition is **DENIED**.

The application will be returned to the examiner's docket to await treatment on the merits in the normal order of examination.


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